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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,236	07/31/2001	Norman Yamamoto	2983-US	5853
63543 7590 11/25/2008 AVERY DENNISON CORPORATION Patent Group Law Department - 3 South P.O. BOX 7090 PASADENA, CA 91109-7090			EXAMINER NORDMEYER, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1794	
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			11/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/920,236

Applicant(s)

YAMAMOTO, NORMAN

Examiner

Patricia L. Nordmeyer

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 4, 14, 20, 23, 24, 29-34 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 14, 20, 23, 24, 29-34 and 37-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 15, 2008 has been entered.

Withdrawn Rejections

2. Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn due to Applicant's amendments and arguments in the response dated September 15, 2008.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 4, 14, 20, 23, 24, 29 – 34, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haugwitz (USPN 4,961,811) in view of Vargas (USPN 4,889,754).

Haugwitz discloses a printable media (Column 2, lines 10 – 14), comprising: a sheet defining a front side (Figure 2), a rear side (Column 2, lines 51 - 53) and at least first and second intersecting side edges (Figure 2), each of the first and second side edges defining opposing longitudinal ends (Figure 2), one of the longitudinal ends of each of the first and second side edges defining a common longitudinal end (Figure 2); a plurality of first strips of adhesive material on one of the front and rear sides of the sheet adjacent to the first side edge (Figure 1; Column 2, lines 51 – 53) and extending substantially from one longitudinal end of the first side edge to the other longitudinal end of the first side edge (Figure 1; Column 2, lines 51 – 53) with a release liner covering the adhesive strips (Column 3, lines 12 – 17) as in claim 14. Haugwitz also discloses a printable media (Column 2, lines 10 – 14), comprising: an at least substantially opaque sheet (Column 2, lines 10 – 11) defining a front side (Figure 2), a rear side (Column 2, lines 51 - 53), first and second horizontally extending side edges (Figure 2), and first and second vertically extending side edges (Figure 2), each of the side edges defining opposing longitudinal ends (Figure 2); a plurality of horizontally extending strips of adhesive (Figure 2) on the rear side (Column 2, lines 51 – 53) of the at least substantially opaque sheet (Column 2, lines 10 – 11) adjacent to the first horizontally extending side edge (Figure 2) and extending substantially from one longitudinal end of the first horizontally extending side edge to the other longitudinal end of the first horizontally extending side edge (Figure 2); wherein a release liner covers the adhesive material (Column 3, lines 13 – 17) as in claims 20 and 2. With regard to claim 23, the sheet comprises a paper sheet (Column 2, line 10). Regarding claims 24 and 29, the sheet is selected from the group consisting of an 8 ½ inch x 11 inch sheet, an 8 ½ inch x 14 inch sheet, and a 210 mm x 297 mm sheet (Column 2, lines 10 – 14). As in claim 34, the strips of adhesive material

are on the rear side of the at least substantially opaque sheet (Column 2, lines 51 – 53); and the front side of the at least substantially opaque sheet includes indicia applied to the at least substantially opaque sheet (Column 2, lines 10 – 14). However, Haugwitz fails to disclose a plurality of second strips of adhesive material on the one of the front and rear sides of the sheet adjacent to the second side edge and extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge, a plurality of first liners respectively positioned over the plurality of first strips of adhesive material; and a plurality of second liners respectively positioned over the plurality of second strips of adhesive material, the pluralities of first and second strips of adhesive material comprise a pressure sensitive adhesive, the pluralities of first and second strips of adhesive material comprise a permanent adhesive, each of the plurality of closely spaced horizontally or vertically extending release liners is spaced from another of the plurality of closely spaced horizontally extending release liners on the rear side of the opaque sheet, each of the plurality of closely spaced horizontally or vertically extending release liners is substantially parallel to another of the plurality of closely spaced horizontally extending release liners on the rear side of the opaque sheet, the plurality of first strips of adhesive material includes at least one strip of permanent adhesive material; and the plurality of second strips of adhesive material includes at least one strip of permanent adhesive material, the plurality of horizontally extending strips of pressure sensitive adhesive is horizontally extending strips of permanent pressure sensitive adhesive; and the plurality of vertically extending strips of pressure sensitive adhesive is vertically extending strips of permanent pressure sensitive adhesive, the plurality of first liners includes mitered ends adjacent

to the common longitudinal end of the first and second side edges and a liner corner member adjacent to the common longitudinal end of the first and second side edges.

Vargas teaches plurality of second strips of adhesive material on rear sides of the sheet adjacent to the second side edge and extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge (Column 3, lines 1 – 15), a plurality of first liners respectively positioned over the plurality of first strips of adhesive material (Column 3, lines 1 – 15); and a plurality of second liners respectively positioned over the plurality of second strips of adhesive material (Column 3, lines 1 – 15), the pluralities of first and second strips of adhesive material comprise a pressure sensitive adhesive (Column 4, lines 59 – 61), each of the plurality of closely spaced horizontally or vertically extending release liners is spaced from another of the plurality of closely spaced horizontally extending release liners on the rear side of the sheet (Column 3, lines 1 – 15), each of the plurality of closely spaced horizontally or vertically extending release liners is substantially parallel to another of the plurality of closely spaced horizontally extending release liners on the rear side of the sheet (Column 3, lines 1 – 15) for the purpose of selectively exposing the adhesive area (Column 3, lines 10 and 11).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the adhesive strips along both the horizontal and vertical edges and covered with release liners in Haugwitz since Haugwitz discloses that the size and

numbers of lines of adhesive control the affixation of the adhesive (Column 2, lines 66 – 68) while Vargas teaches selectively exposing the adhesive area.

With regard to the limitations of "the plurality of first liners includes mitered ends adjacent to the common longitudinal end of the first and second side edges and a liner corner member adjacent to the common longitudinal end of the first and second side edges", it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. In the instant case, the application does not indicate any new, significant attributes of the invention due to the shape of the release liner which would have been unforeseen to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the release liner. One skilled in the art would have been motivated to do so in order to change the appearance of the overall product.

With regard to the limitation of "by a laser printer or an ink jet printer" in claim 34, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

5. Claims 35, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haugwitz (USPN 4,961,811) in view of Vargas (USPN 4,889,754) as applied to claims 2, 4, 14, 20, 23, 24, 29 – 34, 39 and 40 above, and further in view of Chen et al. (USPN 4,898,323).

Haugwitz, as modified with Vargas, discloses the claimed printable media except for the pluralities of first and second strips of adhesive material comprise a permanent adhesive, the plurality of first strips of adhesive material includes at least one strip of permanent adhesive material; and the plurality of second strips of adhesive material includes at least one strip of permanent adhesive material, the plurality of horizontally extending strips of pressure sensitive adhesive is horizontally extending strips of permanent pressure sensitive adhesive; and the plurality of vertically extending strips of pressure sensitive adhesive is vertically extending strips of permanent pressure sensitive adhesive.

Chen et al. teach that the adhesive is a permanent adhesive (Column 5, lines 25 – 26) that is covered by a release liner (Column 5, lines 26 – 29) as part of a printable media (Column 2, lines 9 – 10) of a standard or larger size paper (Column 1, lines 35 – 38) for the purpose of changing the formation of the printed media (Column 1, lines 50 – 52).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the permanent adhesive in the modified Haugwitz in order to change the formation of the printed media as taught by Chen et al.

Response to Arguments

6. Applicant's arguments with respect to claims 2, 4, 14, 20, 23, 24, 29 – 35 and 37 – 40 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's argument that the Cooprider patent specifically teaches away from using additional adhesive and covering it with a liner, please see the new rejection above.

In response to Applicant's request for the Supervisory Patent Examiner to review and sign the office action, please see signature below.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794

/Rena L. Dye/
Supervisory Patent Examiner, Art Unit 1794

